

M. Koščík : "Sucks Cases" in WIPO Domain Name Decisions

"SUCKS CASES" IN WIPO DOMAIN NAME DECISIONS

by

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Does the use of a domain name for criticism constitute the use of the domain name in Bad Faith?

Is there any right to register a domain name confusingly similar with the name of a well known company to tell other people that it is vivisecting animals? Or is it a legitimate interest to register domain name like bridgestonesucks.com when your car skids on the wet road?

Generally speaking there are two approaches to answer these questions. The first approach says that the right to criticize does not extend to registering a domain name that is identical or confusingly similar to the owner's registered trademark. Second approach considers the freedom of speech and says that there is a legitimate interest in using the trademark as part of the domain name of a criticism site if the use is fair and non-commercial.

Both approaches can be found in the WIPO domain name decisions. The main issue is to consider whether defendants in "sucks cases" are really intending to practice their freedom of speech or are just trying to blackmail the complainants. To prove a good faith defendants have to prove that they are not competitors of complainants in any way and that they have no commercial profit from their sites. If there is no other intent than to protest and to ridicule the complainants, the defendants have legitimate interests in respect of the disputed domain name.

Introduction: The Conflict of Trademark Law and the Right of Free Speech [1]

One of the specificities of a domain name is its uniqueness, i.e. it can be registered and used by only one subject. This feature became frequently

abused so called cybersquatters, who registered domain names identical to trademarks of companies with intention to sell the rights to these domain names for exaggerated prices or to blackmail trademark owners to sell them to their competitors. To face cybersquatters, ICANN created a Uniform Domain Name Dispute Resolution Policy, to develop efficient protection of trademark rights against cybersquatting, in the form of arbitration usually by Arbitration and Mediation center at WIPO.

However, cybersquatters were not only internet users who tried to register domain names identical or similar to registered trademarks. Some individuals who were for various reasons upset with companies that own trademarks, their products, services, practices etc. found internet as a perfect place to criticize these companies. These criticism websites were frequently put under the domain names that contained registered trademarks and got into a conflict with trademark owners, frequently by adding words like sucks, blows, boycott etc. This conflict gave rise to a question, whether UDRP protects trademarks also from being used by their own critics.

This work will discuss this question in light of three points set by article 4 of UDRP policy which are discussed in every domain name dispute decided by WIPO Arbitration and Mediation center.

The Disputed Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights [2]

In case the domain name is identical to a registered trademark in a form of e.g. <Trademark.com>, the complainant has to prove only that his trademark right really exists.

Much more complicated question is, whether adding some word which only modifies the trademark <modifier+trademark.com> or <trademark+modifier.com> can be considered to be confusingly similar to a trademark.

WIPO panelists don't have unified approach to this question. For example in the case of domain name ADTSucks.com domain name the decision states that adding the word sucks does nothing to deflect the impact of the

mark to the Internet user.¹ Similar verdict could be found in the decision in the case of a dispute no. D2006-0811 where panelists found domain name www.wallmartblows.com to be confusingly similar to the trademark WALMART.² On the other hand, the decision in the WIPO case no. D2006-0812 stated about the domain name www.boycottwallmart.com that: It would be perfectly clear to anyone who recognized the Complainant's trademarks that the disputed domain name would not resolve to a site used by the Complainant to promote its own goods or services³ and denied the complaint without proceeding to discussion of points 4(ii) or 4 (iii) of UDRP policy.

Surely, no reasonable person fluent in English language will associate domain names like fucknetscape.com, bridgestonesucks.com or boycottwalmart.com with Netscape, Bridgestone or Wal-Mart companies. It is obvious that these domain names would not be registered by these companies, and that websites under these domain names probably are made to criticize or ridicule the trademark owners. With respect to this view of majority of internet users, we can assume that there is no confusing similarity. On the other hand, in some cases, domain names with suffixes or prefixes could be confusingly similar despite strong swearwords or slang. For example word "sucks" has pejorative meaning in American slang, but for the persons who are not familiar with this slang means word sucks just a common English verb. This can cause confusion among users from non-English countries and can constitute confusing similarity mainly with trademarks of companies which are focused mainly on customers who are not from Anglo-American countries. However, even slang words are usually presumed to be understandable, and as it is stated in the case of walmartblows.com: the Complainant must show that their customers or those members of the public likely to be their customers would be confused as to whether the Complainant was associated with the domain name. In

¹ World intellectual property organization: Domain name decision: D2001-0213. Retrieved November 15th 2006, From <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0213.html>.

² World intellectual property organization: Domain name decision: D2006-0811. Retrieved November 15th 2006, From <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0811.html>.

³ World intellectual property organization: Domain name decision: D2006-0812. Retrieved November 15th 2006, From <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0812.html>.

demonstrating this, the Complainant may show evidence that their clientele would not understand that the term is derogatory and therefore would be confused as to who was the owner or operator of the web site.⁴ Furthermore, there are some companies whose products or services are directly related to “sucking”, like e.g. manufacturers of vacuum cleaners. It is indisputable, that in such cases the slang word added to a trademark word (e.g. hypothetical domain name like electoluxsucks.com) will not distinguish the domain name from registered trademark sufficiently. Even lower rate of distinguishing from registered trademarks can be seen among domain names that combine registered trademark with common words like about (aboutwallmart.com), campaign (covancecampaign.com).

Generally speaking, when a similar domain name is disputed, panelist usually provides a long discussion where he gives examples of previous decisions and in the end supports either the thesis that adding modifier creates confusing similarity or the opinion that it doesn’t make confusion at all. It is not a purpose of this work to decide which of these two stances are more rational or just. I dare to say, that this question has to be answered for each case individually, keeping in mind the aim of UDRP policy which is mainly to prevent cybersquatting and not to protect trademark owners from criticism. It is understandable that the creator of the criticism site wants to promote his site, and that a domain name identical or similar to a name of criticized subject is much more likely to attract attention of people to whom is the content of a webpage addressed. Much more important question that has to be answered is whether the use of the domain name (even if confusingly similar) for a criticism site generates rights and legitimate interests of its registrant. In case we answer on this question positively then the similarity and dissimilarity of domain names is out of question.

Rights and Legitimate Interests [3]

ICANN’s uniform domain name resolution policy defines three circumstances indicated that the respondent can demonstrate rights and legitimate interests in the Domain Name Responding to a complaint.

⁴ *World intellectual property organization: Domain name decision: D2006-0811*. Retrieved November 15th 2006, From <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0811.html>

- a. use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services
- b. respondent has been commonly known by the domain name, even if he has acquired no trademark or service mark rights
- c. a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue

It is not very common that criticism web sites offer goods or services, without falling under suspicion of creating the likelihood of confusion to attract internet users for commercial gain. This conduct would be usually considered to be contrary to the UDRP condition of fair, noncommercial use.

It is also not very probable that respondent in this kind of disputes will be commonly known by the domain name. In the majority of cases, is the principal question , whether using a domain name for criticism constitutes a fair use of the domain name and whether is it a tarnishing of trade and service marks.

There are two contrasting views on the question of fair use of domain name among panelists at WIPO. Both views agree that there is a right to operate a criticism webpage, nevertheless, the first view denies that the purpose of criticism could ever constitute the right or legitimate interest in the use of a domain name which is identical or confusingly similar to a registered trademark or service mark. Panelists who are in favour of the second view put the freedom of speech on the same or higher level as trademark rights and in conflict of these two rights usually prefer first come first served principle.

The main argument of supporters of this view is that the right to express one's views is not the same as the right to identify itself by another's name when expressing those views.⁵ This argumentation accepts the right of expression, but only to an extent where it doesn't cause confusion among

⁵ World intellectual property organization: Domain name decision: D2004-0136. Retrieved November 15th 2006, From <http://www.wipo.int/amc/en/domains/decisions/html/2004/d2004-0136.html>.

internet users. We can agree with this stance, but we have to add, that the extent of confusion among internet users must not be evaluated purely from the domain name itself, but also from the content of the website associated with this domain name. Even if the domain name could cause the initial confusion of an internet user, the critical or satirical content of the webpage or eventual appropriate form of disclaimer could remove this confusion. For example, the domain name www.whitehouse.org could cause the initial confusion among internet users who could consider this to be a domain of the president of the USA, however the satirical content of the website, which contains cartoons of G.W. Bush or other members of US government, makes internet users understand immediately, that the website is not operated by the White House. We hold the opinion that operating a critical or satirical website under the domain name that is identical or confusingly similar to another person or trademark, can not be automatically considered as identification of oneself by another's name, and the manner of how the domain name will be perceived by internet users in a context has to be taken into account.

Some panelists hold the opinion that the defendants in these cases do not have the rights and legitimate interests to the domain names that are identical, but have rights and legitimate interests to operate a criticism website under a domain name that adds suffix or prefix to a registered trademark.⁶ This point of view seems to be a reasonable compromise that balances the rights of trademark owners and freedom of speech of those who want to criticize them. However, as discussed above and below we hold the opinion that the decision making about fair and legitimate use of a domain name can not be done on the basis of automatic rule for legitimacy.

The second view is supported mainly by US panelists. One of the most important decisions supporting this view was the decision *Bridgestone Firestone, Inc., Bridgestone/Firestone Research, Inc., and Bridgestone Corporation v. Jack Myers* D2000-0190 which stated:

⁶ *World intellectual property organization: Domain name decision: D2000-1314*. Retrieved November 15th 2006, From <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1314.html>.

Although free speech is not listed as one of the Policy's examples of a right or legitimate interest in a domain name, the list is not exclusive, and the Panel concludes that the exercise of free speech for criticism and commentary also demonstrates a right or legitimate interest in the domain name under Paragraph 4 (c)(iii). The Internet is above all a framework for global communication, and the right to free speech should be one of the foundations of Internet law.⁷

Because the respondent used domain name purely for criticism and did not perform any commercial or business related activities on the website under this domain name the panel denied the complaint and admitted that respondent has legitimate fair use and free speech rights to these domain names. Even though arbitrators used some persuasive arguments to support this view, these arguments were mainly based on the first amendment of US constitution, the doctrine of fair use which is recognized by the US law and previous decisions of US courts. These arguments are often subscribed by US panelists, but are unlikely to be adopted by WIPO panelists from other countries.

The possible solution and attempt to find compromise between US and European views could be found in the decision in the case of Covance, Inc. and Covance Laboratories Ltd. v. The Covance Campaign D2004-0206, where a pharmaceutical company sued a radical group of animal rights activists who operated a website www.covancecampaign.com. This website was critical to the complainant's research methods like vivisection. It contained, e.g. a list of complainants customers, drastic photos of dead animals and cartoons ridiculing the complainant. It also offered T-Shirts, Posters and other merchandise with logos and phrases aimed against the vivisection method. The complainant claimed the transfer of the domain name on itself, setting forth that the mere addition of the generic word "campaign" to the Complainants' trade mark COVANCE does not remove the likelihood of confusion between the trade mark and the Disputed Domain Name and that respondent lacks rights and legitimate interest because it uses its website to tarnish the Complainants' trade mark

⁷ World intellectual property organization: Domain name decision: D2000-0190. Retrieved November 15th 2006, From <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0190.html>.

COVANCE.

The discussion and findings part of this decision is very progressive. Because the website was based outside the USA, panelists acknowledged that the view used in *Bridgestone* decision would not be appropriate. They attempted not to import unique national legal principles into the interpretation of paragraph 4(c) of the Policy.⁸ Instead, they tried to interpret this paragraph in light of its purpose and came to a conclusion that the policy clearly seeks to balance the trade mark owner's right against the rights of a domain name owner in circumstances where use of the trade mark as part of the domain name is truly for the purposes of criticism and the domain name owner in no way seeks to make a commercial use of the trade mark or to tarnish it. Nowhere is it expressly anticipated by the Policy that this paragraph may not operate if the domain name at issue is found to be identical or confusingly similar to the Complainant's trade mark.⁹ The panel further decided to distinguish the degree of initial confusion between identical and confusingly similar domain names. Domain names which are just confusingly similar are less likely to create confusion among users than domain names identical to the complainant's trade mark, so they should be more likely to constitute legitimate, fair use. The panel also emphasized that this spectrum of confusion is not susceptible of some kind of brightline analysis or automatic rule for legitimacy and encouraged panellists of future cases to consider each case in light of all circumstances of the case and in light of ADRP policy's aims. We are pleased to note, that nowadays many panellists subscribe this view.

As to the domain name, panel found that the word campaign has a function of a modifier and, in connection with the website content, it is unlikely that the public will be misled and found legitimate and fair non-commercial use of a domain name. As to the question of possible tarnishment of the trademark, the panel quoted the decision in the case of *Britannia Building Society v. Britannia Fraud Prevention*, WIPO Case No.

⁸ *World intellectual property organization: Domain name decision: D2004-0206*. Retrieved November 15th 2006, From <http://www.wipo.int/amc/en/domains/decisions/html/2004/d2004-0206.html>.

⁹ *World intellectual property organization: Domain name decision: D2004-0206*. Retrieved November 15th 2006, From <http://www.wipo.int/amc/en/domains/decisions/html/2004/d2004-0206.html>.

D2001-0505 which found that domain names can tarnish trademarks only by unrelated pornographic, violent or drug-related images or information to an otherwise wholesome mark. ... In contrast, fair-use criticism, even if libelous, does not constitute tarnishment and is not prohibited by the Policy, the primary concern of which is cybersquatting. We subscribe to this opinion that opposes to a premise often used by panellist that pure adding pejorative word or word of hate constitutes tarnishment of a trade mark.

Registered and Used in Bad Faith [4]

If the panel finds that respondent has rights and legitimate interests to a domain name, it has to discuss also whether these rights are exercised in a good faith. To establish a bona fide use in these cases, the domain name has to be really used for the purpose of criticism. The freedom of speech does not protect conduct where the criticism website is just a for of disguise for commercial website that offers goods or services, or is established or used by a direct competitor. Moreover, criticism can not protect cybersquatters, who set up some kind of criticism site under a domain name, which they in fact intend to sell domain name to a trademark owner. We also have to add that domain name that contains critical modifier like <Ihate+trademark.com>, <trademark+sucks.com> can not be considered to be used for criticism without a critical website operated under this name. We also have to add, that arbitrators have to consider all particular circumstances of every individual case when discussing the registration and use of domain name.